

## REMARKS

The Examiner stated that Applicant's arguments [see Remarks, pages 14-16] with respect to claim 172 have been considered but are moot in view of the new ground(s) of rejection necessitated due to amendment to claim 172 and further, the applicant's arguments presented against references, Lynch, Joseph and Walker are not persuasive for the following reasons:

(i) The amendment filed 12/19/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

the first good or service being currently available at a time of the communication", (see lines 6-7 of claim 172) and "offering the second good or service to the prospective customer in lieu of the first good or service whereby the Upsell serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer." (see claim 172, lines 19-22).

The Examiner stated that the disclosure of the applicant does not teach specifically that the first good or service is currently available at the time of establishing a communication for a purpose of primary transaction for the first good or service and that the disclosure, further, see col. 19, lines 24-38 teaches that the upsell serves to obviate the purpose for the primary transaction only when the purpose of the primary transaction is a customer service or repair and the disclosure does not teach that the upsell serves to obviate the purpose for the primary transaction if the purpose of primary transaction is goods.

- (ii) In response to applicant's arguments against Lynch reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
- (iii) The applicant's arguments against the Joseph reference are not persuasive because the limitation, "the first good or service being currently available at a time of the communication", that he is arguing is not disclosed by Joseph is also not supported by his disclosure, as analyzed above. Rather the applicant's specification, like Joseph, teaches considering offering upsell when the requested item is not available, see patent '513, col. 10, lines 25-33.
- (iv) The applicant's arguments against the Walker reference are persuasive in view of the amendments made to claim 172 but are moot in view of the reasons given in (iii) above and due to new grounds of rejection necessitated due to amendments to claim 172.

The Examiner stated that the amendment filed 12/19/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure and 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention and the added material which is not supported by the original disclosure is as follows:

"the first good or service being currently available at a time of the communication", (see lines 6-7 of claim 172) and "offering the second good or service to the prospective customer in lieu of the first good or service whereby the upsell serves to obviate the purpose for the primary

transaction such that the first good or service is not offered to the prospective customer." (see claim 172, lines 19-22).

The Examiner stated that the disclosure of the applicant does not teach specifically that the first good or service is currently available at the time of establishing a communication for a purpose of primary transaction for first good or service and rather the applicant's specification, like Joseph, teaches considering offering upsell when the requested item is not available, see patent '513, col. 10, lines 25-33.

The Examiner stated that the disclosure, further, see col. 19, lines 24-28 teaches that the upsell serves to obviate the purpose for the primary transaction only when the purpose of the primary transaction is a customer service or repair and the disclosure does not teach that the upsell serves to obviate the purpose for the primary transaction if the purpose of the primary transaction is goods.

The Examiner stated that the applicant is required to cancel the new matter in the reply to this Office Action.

The Examiner stated that claims 172-177, 179-194, and 196-219 is rejected under 35 U.S.C. 112, first paragraph, as facility to comply with the written description requirement.

The Examiner stated that claim 174 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Examiner stated that claim 172-177, 179-183, 189-194, 200-202, 208-212, and 219 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Wagner [Wagner, Lon (Staff Writer); Fry Fight as Fast-Food Chains Face Off With French Fries, We Weight The Issue For You"; Virginian-Pilot, Norfolk, VA; April 06, 1997 extracted on Internet

from Proquest Database] in view of Perkins [Perkins, Ed; "Consumer Reports On Travel Careful shopping will avoid bait-and-switch promotions"; The Atlanta Constitution; Atlanta, Ga; Jan 4, 1995 extracted on the Internet from Proquest Database] and further in view of Kurtzman [Kurtzman, II et al. US Patent 6,144,944].

The Examiner stated regarding claim 172, Lynch teaches a method for providing offers of an item constituting a good or a service to prospective customers as users of the system, utilizing an electronic communications device (see at least abstract. Lynch offers travel-related products and services via a communication device.).

The Examiner stated that regarding claim s173 and 176, the limitations that the primary transaction type differs from the transaction type of the upsell transaction and that the goods/services of first transaction differs from that of the upsell transaction are already covered in the rejection and analysis of claim 172 above because the upsell transaction is directed to a different product with a higher price than the primary transaction.

The Examiner stated that regarding claims 174-175, and 177 their limitations are covered in claim 172 because as per the definition of goods and services, see above, both of these terms are to be used interchangeably and include tickets and printed material.

The Examiner stated that regarding claims 179-183, Lynch/Wagner/Perkins/Kurtzman further discloses that the primary transaction could be: not consummated, a purchase transaction, a service transaction, a sale transaction, an informational enquiry and (see at least Lynch col. 8, lines 19-27, which discloses booking arrangements that meet the requirements of the itinerary and this corresponds to a purchase transaction for the buyer, a sales transaction for the seller.

The Examiner stated that regarding claims 189-194, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers as disclosed and analyzed above and that Lynch/Joseph/Walker/Kurtzman further discloses utilizing time as a factor in determining the goods or service to be offered, wherein the time is the time of the day/day of the week/day of the month/proximity to a calendar event which is user defined (see Lynch at least col. 5, lines 21-30).

The Examiner stated that regarding claims 200 and 201, their limitations are already covered in claim 172 while analyzing the limitations, "utilizing at least in part the primary transaction data....".

The Examiner stated that regarding claim 202, its limitations are already covered in claim 172 while utilizing the limitation, "...utilizing the identity of the prospective customer to obtain at least a second data element relating to the user".

The Examiner stated that regarding claims 208-211, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 teaches a method for providing offers of an item constituting a good or a service to prospective customers utilizing an electronic device as disclosed and analyzed above.

The Examiner stated that regarding claim 212, Lynch/Wagner/Perkins/Kurtzman further discloses at least one negative rule when the at least one item for prospective upsell to the prospective customer is determined (see at least Lynch col. 3, line 63-col. 4, lines 13).

The Examiner stated that regarding claim 219, Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 further discloses that the electronic communications device is a computer (see at least Lynch, FIG. 1, FIG. 2, "34", and col. 4, lines 25-65).

The Examiner stated that claims 184-188 are rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 in view of Official Notice.

The Examiner stated that claims 196-199 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman in view of Pocock (US Pub. 2002/0023272 A1).

The Examiner stated that claims 203-207 are rejected under 35 U.S.C.(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman and further in view of Kenney (US Patent 6,381,583).

The Examiner stated that claims 213-214 are rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 and further in view of Official Notice.

The Examiner stated that claim 215 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman as applied to claim 212 and further in view of Bernard et al. (US Patent 5,918,213), hereinafter, referred to as Bernard.

The Examiner stated that claims 216-217 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 and further in view of Tagawa (5,732,398).

The Examiner stated that claim 218 is rejected under 35 U.S.C. 103(a) as being obvious over Lynch/Wagner/Perkins/Kurtzman as applied to claim 172 and further in view of Gerszberg et al. (US Patent 5,970,473), hereinafter, referred to as Gerszberg.

**Applicant's Reply**

The Examiner stated "the first bid or service being currently available at a time of the communication was not supported by the original disclosure". In the summary of the invention, the following is provided: in one aspect of the invention, a method provides offers of an item constituting a good or a service in the form of an offer for purchase of the item to potential customers as users of the system, utilizing an electronic communications device. Based on this information, which is contained in the original disclosure, supports a first good or service being currently available at a time of the communication.

The Examiner stated the second good or service was not supported by the original disclosure. In the Abstract, the following is provided: the offer of the upsell is preferably generated and offered in real time, that is, during the course of the communication initiated with the primary transaction or primary interaction. Based on this information, which is contained in the original disclosure, offering the second good or service is supported.

The Examiner stated whereby the upsell serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer. In the detailed description of the invention the following is provided in reference to Figure 4: during the course of the primary transaction, processing step 142 serves to receive data at a address website and process the primary transaction. That transaction may be optionally consummated or not as suits the overall purpose of the transaction. By way of example, if the upsell serves to obviate the purpose for the primary transaction, such as when the primary transaction is for customer service or repair, and the upsell is successful in providing the customer with a new product in replacement thereof, then the primary transaction needs not be consummated in the

manner contemplated by the user at the point of initiate contact. Based on this information, which is contained in the original disclosure, the upsell serves to obviate the purpose for the primary transaction such that the first good or service is not offered to the prospective customer is supported. Applicant would like to stress that the description of the primary transaction in relation for a customer service or repair is by way of example only.

As such Applicant believes claim 172 is in condition for allowance and all the claims that depend from claim 172 are also in condition for allowance and respectfully requests they be placed in condition for allowance.

Respectfully submitted,

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